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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,749	06/20/2006	Pavel Skarabela	U 016242-0	7952
140	7590	12/23/2008		
LADAS & PARRY LLP 26 WEST 61ST STREET NEW YORK, NY 10023			EXAMINER WOLF, JUSTIN P	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			12/23/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/584,749

**Applicant(s)**

SKARABELA, PAVEL

**Examiner**

JUSTIN WOLF

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)
- Paper No(s)/Mail Date 06/20/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1-7 objected to because of the following informalities: Claims 1-7 are objected to for the use of the word point instead of claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 rejected under 35 U.S.C. 102(b) as being anticipated by Weiner (US 5628396).

**Regarding claim 1**, Weiner discloses an advertising medium with adhesively attached pieces of paper on which messages can be printed. The attached paper of Weiner can also be detached to wrap used chewing gum (Col. 2, lines 54-58; Fig. 1, 42).

4. Claims 1 and 3-5 rejected under 35 U.S.C. 102(b) as being anticipated by Bustamante (US 1885076).

**Regarding claim 1**, Bustamante discloses an object to provide advertising novelty adapted to have a large amount of advertising in a small space (Col.1, lines 9-13). The object of Bustamante also has a plurality of separate leaves of paper inside the cover (1) (Col. 1, lines 38-45).

The recitation in the claims that the inserted papers is “for used chewing gum” is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Bustamante discloses the inserted papers as presently claimed, it is clear that the inserted papers of Bustamante would be capable of performing the intended use, i.e. disposal of used chewing gum, presently claimed as required in the above cited portion of the MPEP.

**Regarding claim 3**, Bustamante discloses the cover (Fig. 1, #1) being made of cardboard (Col. 1, lines 38-40).

**Regarding claim 4**, Bustamante discloses a printed advertisement on the face of the folded cover (Fig. 2).

**Regarding claim 5**, Bustamante discloses a printed message on the front surface of the first paper (Fig. 1).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner (US 5628396) as applied to claim 1 above, and further in view of Davidson (US 1547101).

**Regarding claims 2, 3 and 4,** Weiner discloses everything from the aforementioned claim 1.

Weiner fails to disclose adhering the papers to a folded cover.

Davidson discloses a cover made of cardboard in which has back and a front flap (Fig.1, # 1, 3, 5) corresponding to applicants cardboard cover (1) and folding cover (5) (Col. 1, lines 45-51; Col.2, line 1). Furthermore, the front flap (3) of Davidson is received beneath front section (5) when in the closed position (Col.2, lines 95-97). Davidson also discloses a printed advertisement on the front of the cardboard cover (Col.2, lines 77-80).

It would have been obvious to one of ordinary skill in the advertisement art at the time of the invention to modify the advertising paper tablet of Weiner to include the cover of Davidson because the cover would allow for strength and durability of the product (Col. 1, lines 9-11).

**Regarding claim 5**, Weiner discloses a printed message on the papers in the tablet.

**Regarding claim 6**, it would have been obvious to one of ordinary skill in the art at the time of the invention to use recycled material for the inserted papers because it would allow for environmentally and ecologically friendly disposal.

Furthermore, Weiner discloses the claimed invention except for the use of recycled material for the inserted papers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute recycled paper for any other paper, since it had been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. *In re Leshin*, 125 USPQ 416.

**Regarding claim 7**, Davidson discloses the folding over of the front flap (3) to complete the package as explained above. In addition, the use of recycled material for the inserted papers is obvious to one of ordinary skill in the art at the time of the invention as explained in claim 6 above.

7. Claims 1-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Bustamante (US 1885076).

**Regarding claim 1**, Bustamante discloses an object to provide advertising novelty adapted to have a large amount of advertising in a small space (Col.1, lines 9-13). The object of Bustamante also has a plurality of separate leaves of paper inside the cover (1) (Col. 1, lines 38-45). The papers of Bustamante are detachable and therefore could be detached for the use of covering used chewing gum.

**Regarding claim 2**, Bustamante discloses a folded cover (Fig. 1, #1), a plurality of inserted leaves or strips (Fig. 1, #3), stapled together (Fig. 2, #2) to enable each piece of paper to be removed from the object (Col. 2, lines 50-61).

Furthermore, Bustamante discloses the claimed invention except for the use of glue for the inserted papers instead of staples. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute glue for the staples as the adhesion method, since it had been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. *In re Leshin*, 125 USPQ 416.

**Regarding claim 3**, Bustamante discloses the cover (Fig. 1, #1) being made of cardboard (Col. 1, lines 38-40).

**Regarding claim 4**, Bustamante discloses a printed advertisement on the face of the folded cover (Fig. 2).

**Regarding claim 5**, Bustamante discloses a printed message on the front surface of the first paper (Fig. 1).

**Regarding claim 6**, it would have been obvious to one of ordinary skill in the art at the time of the invention to use recycled material for the inserted papers because it would allow for environmentally and ecologically friendly disposal.

Furthermore, Bustamante discloses the claimed invention except for the use of recycled material for the inserted papers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute recycled paper for any other paper, since it had been held to be within the general skill of a

worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. *In re Leshin*, 125 USPQ 416.

**Regarding claim 7**, Bustamante discloses the folding over of the cover (Fig. 1, #1) to complete the package as explained above. This is also exemplified in the Figure 2 of Bustamante. In addition, the use of recycled material for the inserted papers is obvious to one of ordinary skill in the art at the time of the invention as explained in claim 6 above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN WOLF whose telephone number is (571)270-7085. The examiner can normally be reached on M-Th 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. W./  
Examiner, Art Unit 1794

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794